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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,190	11/26/2001	Hong Michael Dang	100111410-2	9378

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/995,190

Applicant(s)

DANG ET AL.

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/09/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☒ Claim(s) 1-3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>4/19/07</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Reopening Prosecution

In view of the appeal brief filed on 4/09/07, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible. See *MPEP* § 2107. A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77. (Please refer to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for further explanation of the statutory requirement of 35 U.S.C. § 101.)

With respect to Claim 6, Examiner finds such claim to lack a tangible result. Examiner notes that the focus of this analysis is on the result, not the individual steps.

With respect to a tangible result, the final step of independent claims "if a TXP-based file for the network is detected in the outbox, then performing no conversion on the TXP-based file." As the final step of the independent claims does not produce a real-world result, the Examiner finds that there is no tangible result produced.

As discussed during the applicant interview on 4/19/07, the alternative language provided by the claim's numerous if/then statements allows claims to be construed as if the non-conversion is the final step of the process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 - 6, as filed on 2/15/05, are replete with numerous vague and indistinct terminology or claim limitations.

For example, Claim 1 utilizes “and/or” alternative language, while certain claim limitations lack antecedent basis (e.g. referencing “the system” even though there are actually two distinct systems in communication with one another) and lack clear designations of what system the components are located within or where methodologies are being performed.

Claim 2, in addition to the above cited concerns, utilizes the vague terminology of “substantially deleting” (emphasis added).

Claims 4 and 6 also have if/then statements, the wording and/or organization of which, prevents the Examiner from understanding the metes and bounds of any one particular alternative.

Proposed claim language was discussed Applicant and Examiner during the applicant interview on 4/19/07, and Examiner believes that all parties understand the corrections that need to be made to comply with § 112.

Additionally, Examiner would like to communicate one more correction required to satisfy § 112 that was not communicated previously. Claim 2 has the claim language of “A program controlled apparatus ... the apparatus comprising: a first function for

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receiving an XML-based transaction request from a program controlled system for computation." (emphasis added) Claim language as worded makes it unclear whether the apparatus which is receiving the request is receiving it for the purposes of computations (Examiner assumes this is true intent), or whether the apparatus receives the request from a system and that such transmitting system is designed for computational purposes. Claims 1 – 6 possess similar language.

Please examine all claims and, where required, correct appropriately.

Allowable Subject Matter

Claims 1 – 3 are allowed, provided amended language is submitted to comply with the above cited § 112 rejections.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to teach, or suggest, the limitations of:

"locating the file in an outbox" within the first system and "for securely logging and allowing the third party" access to such file. (as claimed in Claim 1); and

"copying the first TXP-based file to an outbox file for secure and automatic access by the financial institution". (as claimed in Claim 2 and Claim 3).

Cretzler (US Patent 5,644,724) discloses a method/system for collecting and remitting taxes from a point-of-sale terminal to a tax authority computer, via a bank computer intermediary. The terminal compiles tax data and transmits it said data to a bank computer intermediary for processing. The terminal in Cretzler does not possess

an outbox allowing a third party, such as the bank computer, to access the terminal to retrieve data contained within the outbox, rather the terminal in Cretzler determines the time at which to transmit the data to the bank computer and the bank computer merely receives the data. Neither this patent, alone nor in combination of others, disclose nor teach the feature of locating such data in an outbox, and allowing a third party access to the outbox to retrieve the information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cretzler (US Patent 5,644,724) in view of Ariathurai (PG Pub. 2002/0198743) and Official Notice.

Regarding Claims 4 - 6, Creztler discloses a method for transmitting tax related data (tax collection information) to a selected financial institution (merchant bank computer), reporting the data (to the merchant bank computer), and remitting funds corresponding to the data to a selected government authority (tax authority bank computer) over an interactive communications network, the method comprising the steps of (see abstract):

- inputting an transaction request (sales transaction data) to a program controlled apparatus (microcomputer) from a system (input device) for computation of sales, the apparatus (microcomputer) transmitting the tax related data (collected taxes) to the selected financial institution (service bank), reporting the data (to the service bank), and remitting the funds corresponding to the data to the selected government authority (tax authority). (see col. 4, lines 16 – 53);
- the apparatus (microcomputer) reading (receiving) the request (sales transaction data) and writing (storing) data of the request (sales transaction data) in a selected input file of a database. (see col. 4, lines 16 – 53);
- the apparatus (microcomputer) parsing (processing) the input file (sales transaction data) to determine whether the transaction request (sales transaction data, including credit/debit number) is valid. (see col. 6, lines 19 – 36);
- if the request (sales transaction data, including credit/debit number) is invalid (such as invalid credit/debit number), then the apparatus creating an file

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(command instruction) including the request and error, and sending the file (DECLINED) as a response to the system (terminal display). (see col. 6, lines 19 – 36)

Creztler does not disclose a method wherein the request is an **XML-based** transaction request; and storing said request in a selected **XML-based** input file of a database; **conversion of data to TXP-based file**. (emphasis added).

Ariathurai discloses a method wherein the request is an XML-based transaction request (XML request) (see p. 4, para. 33; p. 8, para. 101); storing said request in a selected XML-based input file of a database (see pp. 2 – 3, para. 19); the apparatus (server) parsing the XML-based request to determine whether the transaction request is valid (see p. 4, para. 33; p. 8, para. 101); if the request is invalid, then the apparatus creating a file including the request and error, and sending file (XML error message) as a response to the system (see p. 4, para. 33; p. 8, para. 101); and conversion of XML-based files into another file format. (see p. 8, para. 100).

Examiner takes **Official Notice** that usage of TXP-based file format for communication of tax-related information is old and well known in the art of finance and banking.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Creztler by incorporating the receipt and storage of XML-based transaction requests, validating said request, generating responses when said request is invalid and converting said request to an acceptable file format, as disclosed by Ariathurai, as usage of XML-based information requests is standard and

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conventional in Internet-based communication systems, and additional processing of such information requests are also standard and conventional.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Creztler and Ariathurai by incorporating the usage of TXP-based file format for communication of tax-related information, as is old and well known, is standard and conventional for communication of such information.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/27/07
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